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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,434	01/26/2004	Donald E. Black	4012	3611

29356 7590 07/12/2005

JERRY SEMER  
617 CROGHAN ST.  
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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/766,434

Applicant(s)

BLACK, DONALD E.

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-8, 10-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al (3737649). Nelson discloses a tubular member (10) whose outer diameter over an area used for hitting the ball is smaller than the diameter of a conventional bat over an area used for hitting the ball having a bore extending within from an inner end through a distal end of said tubular member; a plurality of weight members (31, 32, 50) within said bore; an inner cap (40) attachable to said inner end of said tubular member for retaining said weight members within said bore; and an outer cap attachable to said distal end of said tubular member for retaining said weight members within said bore (fig 1, 2a). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 2 and 12 : Nelson discloses positionable weight members (fig 2a, 2b).

As to claims 3 and 13 : Nelson discloses a bore of consistent diameter (fig 2a).

As to claims 4, 5, 14 and 15 : Nelson discloses weight members of varying weights and sizes (item 35, 50 fig 1).

As to claims 6, 7, 16 and 17 : Nelson discloses a threaded flanged inner cap (fig 2b, item 40).

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As to claims 8 and 18: Nelson discloses a spring (fig 2b item 41).

As to claims 10 and 20 : Nelson discloses an aluminum tube (3:19-22).

As to claim 11: See claim 1 rejection. Outer cap is considered item 20.

Also,

Claims 1-7, and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Parsons (5149092). Parsons discloses a tubular member (10) whose outer diameter over an area used for hitting the ball is smaller than the diameter of a conventional bat over an area used for hitting the ball having a bore extending within from an inner end through a distal end of said tubular member; a plurality of weight members (22,20 ) within said bore; an inner cap ( 36) attachable to said inner end of said tubular member for retaining said weight members within said bore; and an outer cap attachable to said distal end of said tubular member for retaining said weight members within said bore (fig 1,2). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 2 and 12 : Parsons discloses positionable weight members (fig 2).

As to claims 3 and 13 : Parsons discloses a bore of consistent diameter (fig 1).

As to claims 4,5,14 and 15 : Parsons discloses weight members of varying weights and sizes (fig 1, items 20,22).

As to claims 6,7, 16 and 17 : Parsons discloses a threaded flanged inner cap (item 16).

As to claim 11: See claim 1 rejection. Outer cap is considered item 36.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson as applied to claims 1 and 11 above, and further in view of Official Notice.

Official notice is taken that the use of plastic is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed any one of several equivalent materials based on cost and design considerations.

Also,

Claims <sup>9, 10</sup> ~~8, 9~~ and <sup>19, 20</sup> ~~18, 19~~ are rejected under 35 U.S.C. 103(a) as being

unpatentable over Parsons as applied to claims 1 and 11 above, and further in view of Official Notice. Official notice is taken that the use of plastic and aluminum is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed any one of several equivalent materials based on cost and design considerations.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,682,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are simply broader than the patent claims and clearly "read" on the claims in the patent.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Michael Chambers  
Examiner  
Art Unit 3711

July 6, 2005

  
GREGORY VIDOVIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700